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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/786,779  | 06/13/2001  | Masahiro Shioi       | 55684(551)          | 6589             |
| 21874   | 7590        | 10/01/2004           | EXAMINER            |                  |
| EDWARDS & ANGELL, LLP<br>P.O. BOX 55874<br>BOSTON, MA 02205 |             |                      | ALAM, SHAHID AL     |                  |
|   |             | ART UNIT             |                     | PAPER NUMBER     |
|   |             | 2172                 |                     | 11               |
| DATE MAILED: 10/01/2004                                     |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |              |
|------------------------------|-----------------|--------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s) |
|                              | 09/786,779      | SHIOI ET AL. |
|                              | Examiner        | Art Unit     |
|                              | Shahid Al Alam  | 2172         |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 09 June 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 16-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 16, 17, 19-27 and 29-34 is/are rejected.
- 7) Claim(s) 18 and 28 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 13 June 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments filed 9 June 2004 have been fully considered but they are not persuasive for the following reasons.

Applicants' argue that the Office Action does not acknowledge the claim to priority and does not indicate whether the certified copies of the priority documents have been received; the Office Action does not indicate whether the drawings are acceptable; Kawai Osamu does not teach or suggest to use both a leading frame position and tail frame position such that a still picture and a moving picture can be used as a title image; the combination of Osamu and Mitsuhiko does not form the claimed invention; and failed to establish a *prima facie* case of obviousness.

Examiner respectfully disagrees all of the allegations as argued. Examiner, in his previous office action, gave detail explanation of claimed limitation and pointed out exact locations in the cited prior art.

Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification.

During patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the specification.' Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 162 USPQ 541,550-51 (CCPA 1969).

As per request, the priority of the present application is hereby acknowledged and placed in the file.

The drawings filed on 13 June 2001 are accepted.

Osamu's teaching of a multimedia file management method and management device managing multimedia files using index information, wherein multimedia data of multimedia files can be managed for each predetermined management unit, one or more management units relating to multimedia files are designated as title frames, index information including positional information is generated and added to the multimedia files, which are recorded on a recording medium clearly teaches Applicant's claimed invention as described in the Applicant's disclosure on page 5, lines 6 – 12.

In response to applicant's argument that the combination of Osamu and Mitsuhiko does not form the claimed invention, the examiner recognizes that combination and obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would be obvious to a person of ordinary skill in the art at the time of the invention was made to incorporate index information positional information of moving images at predetermined intervals, and recording the same, and upon doing such, selecting as index information, the appropriate information from among the well-known information that the moving image has, such as positional information or

Art Unit: 2172

encryption information. The combination enables to quickly search a desired image file by previously selecting intra-frame encoding data in each image file and adding the data to the head end of each image file as the index for management.

In response to applicant's argument on page 3, a prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. Once such a case is established, it is incumbent upon appellant to go forward with objective evidence of unobviousness. In re Fielder, 471 F.2d 640, 176 USPQ 300 (CCPA 1973).

For the above reasons, Examiner believed that rejection of the last Office action was proper.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 16, 17, 19 – 27 and 29 – 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent 06195880 A issued to Kawai Osamu et al. and in view of Japanese Patent 07122040 A issued to Hara Mitsuhiko.

With respect to claims 16, 19, 22 and 29, Kawai Osamu teaches generating said index information including a source identifier expressing a source having one or more of said management units associated with said multimedia file as a title frame, positions of a leading frame and tail frame of said title frame in said source, and a position of a reference frame for decoding said leading frame (*a multimedia file management method and management device managing multimedia files using index information, wherein multimedia*

*data of multimedia files can be managed for each predetermined management unit, one or more management units relating to multimedia files are designated as title frames, index information including positional information is generated and added to the multimedia files, which are recorded on a recording medium; see abstract, full text, Figures 1 – 10).*

Kawai Osamu does not explicitly teach recording said index information onto a recording medium, attaching said index information to said multimedia file as claimed. Hara Mitsuhiro teaches claimed recording said index information onto a recording medium, attaching said index information to said multimedia file (*a management method and management device designating as index information positional information of moving images at predetermined intervals, and recording the same; see abstract, paragraph number 0058, Figures 2, 13, 14*).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was to adopt, in the invention described in Kawai Osamu's document with the technical means described in Hara Mitsuhiro's document for designating as index information positional information of moving images at predetermined intervals, and recording the same, and upon doing such, selecting as index information, the appropriate information from among the well-known information that the moving image has, such as positional information or encryption information.

As to claim 17, generating index information includes a step of generating a plurality of pieces of index information and said recording step includes a step of recording said plurality of pieces of index information and information for specifying the number of said pieces of index information onto a recording medium, attaching said plurality of pieces of index information and said information for specifying the number of

Art Unit: 2172

said pieces of index information to said multimedia file (abstract, full text, Figures 1 – 10; Kawai Osamu and abstract, paragraph number 0058, Figures 2, 13, 14; Hara Mitsuhiro).

The subject matter of claims 20 – 21 is rejected in the analysis above in claims 16 and 17 and these claims are rejected on that basis.

The subject matter of claims 23 – 27 are rejected in the analysis above in claims 16 - 17 and these claims are rejected on that basis.

The subject matter of claims 30 – 32 are rejected in the analysis above in claims 16 - 17 and these claims are rejected on that basis.

The subject matter of claims 33 and 34 are rejected in the analysis above in claim 16 and these claims are rejected on that basis.

#### ***Allowable Subject Matter***

3. Claims 18 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art teaches the general state of the art in the relevant technical field, and they describe the above matter; however, none of the documents teaches all of the claimed limitation as described in claims 18 and 28.

***Contact Information***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid Al Alam whose telephone number is (703) 305-2358 (Effective October 21, 2004, the new number should be (571) 272-4030). The examiner can normally be reached on Monday-Thursday 8:00 A.M. - 4:00 P.M.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703) 305-9790 (Effective October 21, 2004, the new number should be (571) 272-4107).

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Shahid Al Alam  
Primary Examiner  
Art Unit 2172

30 September 2004